

REMARKS

Claims 1-24 are pending in this application. Claims 19-22 have been withdrawn while claims 23-24 are new. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-8, 13-16, and 18 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. patent 5,116,318 to Hillstead, in view of U.S. patent 5,843,089 to Sahatjian in view of U.S. patent 6,660,034 B1 to Mandrusov; claims 9-11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hillstead and Sahatjian or Mandrusov, and further in view of Hyde et al. (EP 055396041); and claims 12 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hillstead in view of Sahatjian or Mandrusov, and further in view of Osborn, U.S. patent 5,409,495.

35 USC § 112

Claims 1-18 stand rejected as allegedly containing “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Specifically, the Office argues that the “wherein' clause is not described in the specification,” and that “the specification [does not] disclose[] the new limitations entered in claim 1.” The Office action then recommends that “[i]n order to differentiate between the Sahatjian reference and the Applicant's reference the Applicant[] .. has to positively claim structure limitations of the ... application instead of disclosing what it doesn't do or have.”

In response, the undersigned submits that: (1) there is ample support in the specification for the notion of a coated stent placed on top of a compliant sheath; and, (2) that the previously amended clam language does not violate section 112. Support for the notion that the inventors considered placing a coated stent on a compliant sheath at the time of filing can be found throughout the specification. For one, the title specifically mentions coated stents. For another, the discussion at paragraph 24 of the specification addresses a coated stent and compliant sheath combination when it provides that the “compliant elastic sheath 3 separates the edges of the balloon wings 6 from the inner surfaces of the stent 2,” and that “the protective or therapeutic coating on the surfaces of stent 2 is not disturbed by the unfolding balloon wings.” Thus, the inventors clearly contemplated that the stent may not only be coated, but that this coating may be hardly if at all disturbed as the balloon is expanded. The abstract provides still further support as it discusses how a sheath and a coated stent may be used in accord with the present invention. All these examples show that a coated stent and sheath was contemplated by the inventors.

As to the second argument, reconsideration is requested. The undersigned submits that the wherein clause recites affirmative and acceptable language. The wherein language is

directed to the source of the stent coating, namely, that while some of the coating may have been transferred from the sheath, some of the coating of the stent should also have its origin elsewhere. Moreover, the notion that the coating on the stent may be from a source other than the sheath is further clarified in the claims with the addition of the word coated in claim 1. Thus, while the current invention does not preclude the sheath from also containing a coating, what is now affirmatively recited is that the stent, itself, is coated, at least to some degree. This should resolve any previous perceived ambiguity.

35 USC § 103

The impropriety of combining the references does not need to be addressed as each of the cited references fail to at least suggest or disclose “a compliant sheath located between the stent expansion balloon and the coated stent, wherein at least some of the coating on the inner surface of the coated stent has not been transferred to the stent from the compliant sheath,” which is recited in claim 1. For one, none of the cited references employ a sheath and coated stent as recited. For another, even if the references contained such language, absent the applicants' disclosure, there are no teachings in the references or the prior art that suggest the cited references may be selectively cut and pasted to meet the Patent Office's burden for properly raising an obviousness rejection.

The New Claims

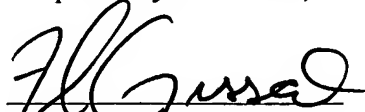
Support for the new claims can at least be found in paragraphs 26 and 28.

CONCLUSION

For at least these reasons, the undersigned requests allowance of the pending claims.

The Commissioner is authorized to charge any fees due under 37 C.F.R. §§ 1.16 or 1.17, or credit any overpayments, to deposit account no. 11-0600. Should the Examiner have any questions, he is invited to call the undersigned at 202-220-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Fred T. Grasso', written over a horizontal line.

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